

The Manual of Patent Examining Procedure at Section 706.07(a) clearly provides as follows:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims. . . .”

It is submitted that the new grounds of rejection herein were not necessitated by amendment of the claims by applicants. In the prior Office Action of May 11, 2005, claim 16, indirectly dependent on claim 1, was said to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The pertinent part of claim 16 read:

...the inspection window is oriented substantially parallel to and spaced from the support member, the arrangement being such that the flow chamber is defined intermediate the support member and the inspection window.

No rejection of this language or claim 16 was made under 35 U.S.C. § 103, second paragraph.

Claim 1, in the Reply to Office Action of November 7, 2005, was amended to add this language of claim 16 as follows:

...the inspection window being oriented substantially parallel to and spaced from the support member such that the flow chamber is defined intermediate the support member and the inspection window...

Similarly, the pertinent part of claim 6 (rejected on prior art but not under Section 103, second paragraph) was added to claim 1 in the Reply of November 7, 2005. Claim 6, dependent on claim 1, read:

...the monitoring unit comprises a fluid permeable support member for supporting the semi-permeable membrane in the flow chamber.

Claim 1 is directed to a monitoring unit and this amendment to claim 1 added:

...a fluid permeable support member for supporting a semi-permeable test membrane in the flow chamber...

Thus, as stated above, neither the language of prior claim 6 nor prior claim 16 was rejected under 35 U.S.C. § 112, second paragraph, in the prior Office Action of May 11, 2005. The Examiner did not hold that either claim was unclear. Yet the Examiner in the present Office Action has rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being unclear because of the language added from these two claims into claim 1. The Examiner's reasoning is as follows:

Claim 1 and dependent claims are unclear as to whether the support member "support the membrane", and the inspection window defines a chamber between the inspection window and "the membrane", as illustrated in the figures. (quotation marks in original)

Applicants have not had the opportunity to address this issue of clarity which the Examiner newly raises.

There is a companion rejection of claim 1 under 35 U.S.C. § 112, first paragraph, for failing to provide enablement for defining a chamber between the support member and the inspection window. As with the rejection under Section 112, second paragraph, discussed above, there was no counterpart rejection of a lack of enablement of either claim 6 or claim 16 under Section 112, first paragraph, in the Office Action of May 11, 2005.

The Examiner, in an attempt to justify the finality of the present Office Action, states that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." As has been shown hereinabove, the existing language

of claims 6 and 16 was merely incorporated into claim 1, was not newly added to the case, and could not have necessitated the new rejection of claim 1.

Both claims 6 and 16 were dependent on claim 1, claim 6 directly and claim 16 indirectly through claim 6. The language which the Examiner now finds objectionable and lacking enablement in claim 1 was present in claims 6 and 16 on which the Examiner acted in the Office Action of May 11, 2005. Thus, the Examiner had the opportunity to make then the rejections she makes now, yet failed to do so. The incorporation of the language of an unobjectionable dependent claim into a parent claim is not the type of amendment contemplated by MPEP § 706.07(a) that would justify the issuance of a final Office Action when a new ground of rejection is made.

There is also a new ground of rejection regarding claim 42, namely, being an improper process under 35 U.S.C. § 101. In the prior Office Action of May 11, 2005, the Examiner stated that claim 42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph. The prior rejection of claim 42 was based on the alleged use of the phrase “such as.” This phrase, however, had already been deleted from claim 42 in a prior Amendment filed before the Office Action of May 11, 2005. Thus, it was not necessary to amend claim 42 in the Reply of November 7, 2005, and, because it is an independent claim, there was no need to rewrite it either.

Claim 42 was not rejected as an improper process claim in the Office Action of May 11, 2005. The present rejection of claim 42 under 35 U.S.C. § 101 is therefore a new ground of rejection, not necessitated by a claim amendment because none was

made. Making the Office Action final is clearly prohibited by the above-quoted section of the MPEP.

The final Office Action of January 26, 2006 was prematurely issued. It is submitted that applicants are entitled to an opportunity to respond fully to the new grounds of rejection without being restricted by the requirements set forth in Rule 116.

In view of the foregoing, it is submitted that an issue has not been reached and that the finality of the Office Action of January 26, 2006 is premature and should be withdrawn.

Please grant any extensions of time required to enter this response and charge any required fees to our Deposit Account 06-0916.

Respectfully submitted,

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